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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,531	08/05/2003	Adam Richard Johnson	PC25201	6060

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WARNER-LAMBERT COMPANY
2800 PLYMOUTH RD
ANN ARBOR, MI 48105

EXAMINER

HABTE, KAHSA Y

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,531

Applicant(s)

JOHNSON, ADAM RICHARD

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-11 are pending.

This restriction requirement replaces the previous restriction requirement.

2. Applicants have elected the invention of Group III, but did not elect a single species as set forth in the restriction requirement. Applicants believe that "a single disclosed species of the invention of Group III is not found in the specification". In response to applicant's amendment, it is deemed necessary to restrict the invention further.

Restriction/Election

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11 (in part), drawn to compounds where **D** in Formula I is 4-oxo-quinazolines (see Examples 1 and 3 on pages 272-273) classified in class 544, subclass 287.
 - II. Claims 1-11 (in part), drawn to compounds where **D** in Formula I is 3a,4,5,6-tetrahydro-thieno[3,2-c]pyridines (see Example 2 on page 273) classified in class 546, subclass 114.
 - III. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is a benzofused six-membered ring with O, S and N (i.e. the third and fourth species on page 307), classified in class 544, subclass 2.

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- IV. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is thiadiazines (i.e. the first 4 diradical groups in claim 1 on page 301, classified in class 544, subclass 3⁺.
- V. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is a benzofused-1,2-thiazines (i.e. the first species on page 307, classified in class 544, subclass 47⁺.
- VI. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is symmetrical triazines, classified in class 544, subclass 180.
- VII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is asymmetrical triazines, classified in class 544, subclass 182.
- VIII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is 1,2-diazines, classified in class 544, subclass 224⁺.
- IX. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is 1,3-diazines, classified in class 544, subclass 242⁺.
- X. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is 1,4-diazines, classified in class 544, subclass 336⁺.
- XI. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is diazinofused-1,3-oxazines, classified in class 544, subclass 91.
- XII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is monoazinofused-1,3-oxazines, classified in class 544, subclass 89.
- XIII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula **I** is 1,3-thiazinofused-1,3-oxazines, classified in class 544, subclass various.

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- XIV. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is pteridines, classified in class 544, subclass 350.
- XV. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is thienofused-1,3-oxazines, classified in class 544, subclass various.
- XVI. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is benzofused 1,3-oxazines, classified in class 544, subclass various.
- XVII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is 1,3-thiazinofused to diazines, classified in class 544, subclass 279.
- XVIII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is 1,3-thiazinofused to monoazines, classified in class 546, subclass 114.
- XIX. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is tricyclic 1,3-diazines (i.e. 5 diradical groups recited on page 305-306), classified in class 544, subclass 250.
- XX. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is naphthyridines (see for example, 6th diradical group on page 305), classified in class 546, subclass 122.
- XXI. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is quinolines and isoquinolines (see for example, 4th diradical group on page 305), classified in class 546, subclasses 139 and 152.
- XXII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is monoazines (see for example, 5th-8th diradical groups on page 303), classified in class 546, subclass various.

- XXIII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is isoindoles (see for example, the last diradical groups on page 311), classified in class 548, subclass various.
- XXIV. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is diazines or monoazines fused to pyrano ring (see for example, the 2nd – 7th diradical groups on page 309), classified in classes 546, subclass 115 and class 544, subclass various.
- XXV. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is benzofused pyrans (see for example, the 1st diradical group on page 309), classified in class 549, subclass various.
- XXVI. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is others (e.g. 1st diradical group on page 310, 3rd diradical group on page 308, etc.), classified in classes 544, 546, 548, 549, subclass various.
- XXVII. Claims 1-6 (in part) and 8-11 (in part), drawn to **D** in Formula I is benzo and naphtho (i.e. non-heterocyclic ring, see for example 4th diradical group on page 303 and 11th – 14th diradical groups on page 310), classified in classes 544, 546, 548, 549 and 564, subclass various.

The inventions are distinct, each from the other because of the following reasons: Groups I-XXVII are directed to structurally dissimilar compounds such that the variable core created by the varying definitions such as **Z**, **Q**, **D**, **V** and **R²** in Formula I do not belong to the same recognized class of chemical compounds in the art, and references

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anticipating one invention, would not render obvious the others. Group I is drawn to quinazolines (pyrimidine fused to benzo ring) and is different from Group II, since Group II is drawn to a bicyclic ring (5-membered ring with one sulfur that is fused to a pyridino ring). Groups I-XXVI are drawn to different heterocyclic core structures and are different one from the other. Group XXVII is different from Groups I-XXVI, since there is no heteroatom in the core structure of Group XXVII (i.e. no heteroatom in ring D). The nature of the heterocyclic ring, type of heteroatoms in the rings, number of heteroatoms in the rings and size of the rings for each core structure is different one from the other. Each heterocyclic ring in Groups I-XXVI has a unique core structure and one skilled in the art would not consider such diverse core structures as equivalents. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structure equivalents of each other.

Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Claude Purchase to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

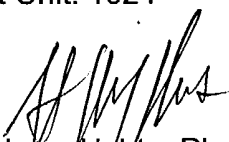
Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

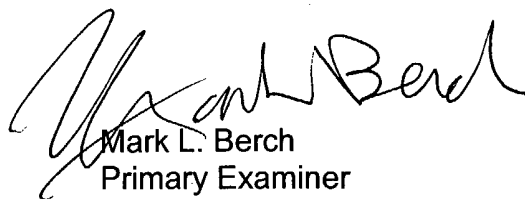
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674, if there is no reply within 24 hours, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mark L. Berch
Primary Examiner
Art Unit 1624

KH

November 10, 2004